Paper No. 14
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Horizonline, Inc.

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Serial No. 75/214,382

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Gunther J. Evanina of Price, Heneveld, Cooper, DeWitt & Litton for Horizonline, Inc.

Barney L. Charlon, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Bottorff, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Horizonline, Inc. has filed an application to register "GEAR BOX" as a trademark for goods identified as "land vehicles in the nature of automobiles."[1] Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used on or in

[1] Serial No. 75/214,382, filed December 17, 1996, based upon an allegation of a bona fide intention to use such term in commerce.

connection with applicant's goods, the mark will be merely descriptive of a significant component of the goods.

When the Examining Attorney made the refusal final, applicant appealed. Briefs were filed, but an oral hearing was not requested.

It is well settled that a term is considered merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); *see also* In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

It is not necessary that a term describe all of the properties of the goods in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with those goods, and the possible significance that the term would have to the average purchaser because of the manner of its use. *See* In re

Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

The evidence of record establishes that "gearbox" or "gear box" is a synonym for a vehicle transmission; and the Examining Attorney's argument that a term must be refused registration under Section 2(e)(1) when it immediately identifies, for a prospective purchaser of the relevant goods, a significant component thereof, is well-grounded in the case law. *See, e.g.*, Scanwell Laboratories, Inc. v. Department of Transportation, Federal Aviation Administration, 181 F.2d 1385, 179 U.S.P.Q. 238 (CCPA 1973) [V-RING merely descriptive of directional antennas, the primary components of which were shaped in the form of a "v" and a "ring"]; In re Walker Manufacturing Co., 359 F.2d 474, 149 U.S.P.Q. 528 (CCPA 1966) [CHAMBERED PIPE merely descriptive of an exhaust system consisting of a series of small tuning chambers]; In re H.U.D.D.L.E., 216 U.S.P.Q. 358 (TTAB 1982) [TOOBS, the phonetic equivalent of the word "tubes," merely descriptive of bathroom and kitchen fixtures formed of tubes].

Applicant readily concedes that "gearbox" is a synonym for a "transmission" and does not contest that automobiles utilize transmissions. Applicant does, however, argue that a transmission, though essential, is not a significant component of an automobile, and argues that merchants "rarely, if ever, make any reference to the transmission of the automobile in their advertisements or descriptions of their vehicles." In addition, applicant argues that the use of "gearbox" to refer to a transmission is "archaic" and transmission itself is more routinely used. Applicant also argues that its "mark is not in common usage in the trade or elsewhere as a description of automobiles, or any other vehicles," and since it seeks registration of "GEAR BOX" *for vehicles*, it will not impede the ability of others to use the term *for transmissions*. Finally, applicant argues that its proposed mark presents a double entendre, i.e., it can be perceived as meaning "transmission" or a vehicle with a box for storing gear; and, because its proposed mark is set forth as two words rather than one, those viewing the mark will be more likely to think of the second meaning.

We agree with the Examining Attorney that a transmission is a significant component of an automobile, and applicant's contention to the contrary has no support.

Moreover, the Examining Attorney has made of record numerous NEXIS references to "gear box" as a synonym for "transmission." These counter both applicant's argument regarding the significance of transmissions in automobiles and applicant's entirely unsupported argument that transmissions are rarely discussed in advertisements or descriptions of automobiles.

The NEXIS evidence also counters applicant's argument that "gearbox" is an archaic term; in fact, the term appears in routine use. Finally, the NEXIS references typically present the term in two-word form, thereby negating applicant's argument that such presentation will lead consumers to view "GEAR BOX" as more likely to mean a box for storing gear.[2]

In regard to applicant's argument that it is not seeking to register "GEAR BOX" for transmissions and that "GEAR BOX" is not commonly used for vehicles, we note the following apt passage from another Board decision:

> This argument might have been relevant had the refusal been that the term sought to be registered was the generic name of the goods. See, e.g., In re Wampole Ltd. 227 U.S.P.Q. 74 (TTAB 1985). Here, it is misplaced as genericness is not the basis for refusal. A term need not be generic of the goods to be held unregistrable

[2] Moreover, since the descriptiveness of a proposed mark must be determined by considering the mark in conjunction with the goods, we find that the use of "GEAR BOX" in conjunction with automobiles will most likely prompt thoughts of transmissions.

under Section 2(e)(1). Sunbeam Corp. v. Conair Corp., 220 U.S.P.Q. 748 (TTAB 1983); In re Wink Corp., 218 U.S.P.Q. 739 (TTAB 1983).

In re Metcal Inc., 1 USPQ2d 1334, 1335-36 (TTAB 1986).

The Examining Attorney bears the burden of showing that a mark is merely descriptive when used on or in connection with the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). We find the burden has been met in this case, and we affirm the refusal of registration.

Decision: The refusal of registration under Section 2(e)(1) of the Trademark Act is affirmed.

C. M. Bottorff

T. E. Holtzman

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board